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| LERNER, DAVID, LITTENBERG, KRUMHOLZ & MENTLIK 600 SOUTH AVENUE WEST WESTFIELD, NJ 07090 | | | ART UNIT 3732 | PAPER NUMBER |

DATE MAILED: 02/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/759,614

Applicant(s)

PATEL ET AL.

Examiner

Robyn Doan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>12/28/04; 08/15/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

Claim 7 is objected to because of the following informalities: claim 7, lines 2-3 "composition" should be changed to --compositions--. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 7 and 18-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 7 contains the phrase "may be" renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention or not, and the resulting the does not clearly set forth the metes and bounds of the patent protection desired. For the purpose of examination, claim 7 will be treated as the fibers of each of the compositions being the same or different.

Claims 18-21 are indefinite because it is not clearly understood which of the two previously claimed types of mascara composition which is claimed in claim 18.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 5-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ounanian (WO 92/19215) in view of Kanji et al (U.S. Pat. # 6,726,917).

With regard to claims 1-2 and 5-6, Ounanian discloses a method of waterproofing eyelashes comprising steps of applying a waterproof mascara composition to the eyelashes over a coat of conventional mascara (page 1, lines 23-29; page 2, lines 19-22 and page 3, lines 19-23 and 26-33). Since Ounanian shows that the conventional mascara is not waterproof mascara, therefore, it is held to be inherently washable. Alternatively, it would have been an obvious matter of design choice to modify the conventional mascara to be washable, since it was known in the art that conventional mascara is washable with soap and water or with mineral oil, i.e. make up remover. Ounanian does not disclose either or both of the washable, waterproof mascara compositions containing fibers. Kanji et al shows a mascara composition (abstract, lines 1-2) having fibers. It would have been obvious to one having an ordinary skill in the art at the time the invention was made to employ the fibers as taught by Kanji et al into either or both washable, waterproof mascara composition of Ounanian for the purpose of lengthening or volumizing the eyelashes. In regard to claim 3, it would have been

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obvious to one having an ordinary skill in the art at the time the invention was made to apply mascara composition over the false lashes it is well known to apply mascara to real or false eyelashes. In regard to claims 8-9, Kanji et al shows the fibers comprising natural fibers which include cotton, silk or wool fibers (col. 3, lines 11-13). In regard to claims 10 and 12-15, Kanji et al discloses the fibers comprising synthetic fibers which include polyester, polyamide, rayon, nylon fibers (col. 3, lines 14-15). In regard to claims 16-17, Kanji et al shows the fibers having an average length of about 0.5mm to 4mm, 1.5mm to about 2.5mm (col. 3, lines 20-22). In regard to claims 18-19, Kanji et al discloses the fibers having a first tacky film former soluble or dispersable in water (col. 5, lines 42-44) and a second tacky film former soluble in oil (col. 5, line 45), the first tacky film former comprising polyvinyl alcohol (col. 5, lines 52-53). In regard to claims 20-21, Kanji et al shows the second tacky film former comprising hydrogenated isobutene (col. 5, lines 45-46). In regard to claims 7 and 11, Ounanina in view of Kanji et al fail to show the fibers of each of the washable, waterproof mascara compositions being the same or different. Ounanina in view of Kanji et al also do not disclose the synthetic fibers comprising elastomeric fibers. It would have been obvious to one having an ordinary skill in the art at the time the invention was made to construct the fibers of each of the washable, waterproof mascara compositions being the same or different, since such modification would involved an obvious matter of design choice in the shape or size of the known component needed to obtain the desired results. And it would have been obvious to one having an ordinary skill in the art at the time the invention was made to construct the fibers comprising elastomeric fibers, since it has been held to be

within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ounanian in view of Kanji et al as applied to claim 1 and further in view of Cannell et al '389(IDS cited reference).

With regard to claim 4, Ounanian in view of Kanji et al disclose a method of applying the washable, waterproof mascara compositions to the eyelashes as discussed above, however, Ounanian in view of Kanji et al fail to show either or both of the washable and waterproof mascara compositions having a lecithin, an amphoteric surfactant and a nonionic surfactant. Cannell et al '389discloses a mascara composition (col. 3, lines 40-50) having an amphoteric surfactant, a nonionic surfactant (col. 3, lines 36-39) and a lecithin (col. 4, lines 22-34). It would have been obvious to one having an ordinary skill in the art at the time the invention was made to employ the amphoteric surfactant, nonionic surfactant and the lecithin as taught by Cannell et al into either or both of the washable and waterproof mascara compositions of Ounanian in view of Kanji et al for allowing the water-insoluble ingredient to be incorporated into the aqueous solution.

Claims 22-27, 30, 32-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pettengill (U.S. Pat. # 5,052,839) in view of Ounanian and Kanji et al.

With regard to claims 22 and 30, Pentingill discloses a mascara system (fig. 1) comprising a first and second reservoirs (11, col. 2, line 6) for allowing each reservoir to contain a different type of mascara (col. 2, lines 11-12, lines 29-33), at least one applicator (fig. 1) having first (13a) and second (13b) applicator members for applying mascara compositions. Pentingill does not disclose the first reservoir containing a washable mascara composition and second reservoir containing a waterproof mascara composition. Pentingill also does not disclose either or both of the washable, waterproof mascara compositions containing fibers. Ounanian, as discussed above, shows a method of applying a washable mascara composition and a waterproof mascara composition to the eyelashes. Kanji et al shows a mascara composition (abstract, lines 1-2) having fibers. It would have been obvious to one having an ordinary skill in the art at the time the invention was made to employ the washable mascara composition and the waterproof mascara composition as taught by Ounanian into the two reservoirs of Pentingill for the purpose of providing a pleasing cosmetic appearance to the user. And It would have been obvious to one having an ordinary skill in the art at the time the invention was made to employ the fibers as taught by Kanji et al to either or both of the washable, waterproof mascara composition of Ounanian into the system of Pentingill for the purpose of lengthening or volumizing the eyelashes. In regard to claims 23 and 32, Pentingill also shows the first and second reservoirs being integral with each other (fig.

1, col. 2, lines 6-7). In regard to claims 24 and 33, Pentingill shows the system having two applicators (14a, 14b), wherein the first applicator (14a) having a first applicator member (13a) and the second applicator (14b) having a second applicator member (14b). In regard to claims 25 and 34, Pentingill discloses one applicator (14a) having handle (12) for manipulation by the user and for closing the reservoirs. In regard to claims 26 and 35, Pentingill shows first and second applicator members (13a, b) being brushes (col. 1, line 61). In regard to claims 27 and 36, Pentingill in view of Ounanian and Kanji et al fail to show the first and second applicator members being different. It would have been obvious to one having an ordinary skill in the art at the time the invention was made to construct the first and second members being different, since such modification would involved an obvious matter of design choice in the shape of a known component needed to obtain the desired results.

Claims 28, 31, 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pentingill in view of Ounanian and Kanji et al as applied to claims 22 and 30 above, and further in view of Arai (Japanese Pat. # 2000203634A)

With regard to claims 28, 31 and 37, Pentingill in view of Ounanian and Kanji et al disclose a mascara system comprising all the claimed limitations in claims 22 and 30 as discussed above except for the system being in a form a blister pack (claim 31) and directions for using the washable and waterproof mascara compositions (28 and 37). Arai discloses a cosmetic system (figs. 1-2) comprising a blister pack (1) holding a cosmetic item (A), the system also having information about the system (translated

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abstract). It would have been obvious to one having an ordinary skill in the art at the time the invention was made to employ the blister pack as well as the information about the system as taught by Arai into the system of Pentingill in view of Ounanian and Kanji et al in order to provide information about the product as well as advertising the product.

Claims 29 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pentingill in view of Ounanian and Kanji et al as applied to claims 22 and 30 above, and further in view of Cannell et al '389.

With regard to claims 29 and 38, Pentingill in view of Ounanian and Kanji et al Inc. disclose a mascara system comprising all the claimed limitations in claims 22 and 30 as discussed above except for either or both of the washable and waterproof mascara compositions having a lecithin, an amphoteric surfactant and a nonionic surfactant. Cannell et al discloses a mascara composition (col. 3, lines 40-50) having an amphoteric surfactant, a nonionic surfactant (col. 3, lines 36-39) and a lecithin (col. 4, lines 22-34). It would have been obvious to one having an ordinary skill in the art at the time the invention was made to employ the amphoteric surfactant, nonionic surfactant and the lecithin as taught by Cannell et al into either or both washable and waterproof mascara compositions of Ounanian and Kanji et al for allowing the water-insoluble ingredient to be incorporated into the aqueous solution.

Double Patenting

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The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-38 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-21 of copending Application No. 10/666,368 in view of Kanji et al (U.S. Pat. # 6,726,917). Claims 1-38 of the instant application read on claims 1-21 of the copending Application No. 10/666,368, except for either or both washable, waterproof mascara composition containing fibers and the characteristic of the fibers as claimed in claims 8-10, 12-21 of the instant application. Kanji et al shows a mascara composition (abstract, lines 1-2) having fibers. The fibers comprising natural fibers which include cotton, silk or wool fibers (col. 3, lines 11-13). Kanji et al also shows the fibers comprising synthetic fibers which include polyester, polyamide, rayon, nylon fibers (col. 3, lines 14-15). Kanji et al further shows the fibers having an average length of about 0.5mm to 4mm, 1.5mm to about 2.5mm (col. 3, lines 20-22). The fibers also having a first tacky film former soluble or dispersable in water

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(col. 5, lines 42-44) and a second tacky film former soluble in oil (col. 5, line 45), the first tacky film former comprising polyvinyl alcohol (col. 5, lines 52-53), the second tacky film former comprising hydrogenated isobutene (col. 5, lines 45-46). It would have been obvious to one having an ordinary skill in the art at the time the invention was made to modify the claims of the copending Application '368 to include the fibers and its characteristic as shown by Kanji et al in order to lengthen or volumize the eyelashes. In regard to claims 7 and 11, copending application '368 in view of Kanji et al fail to show the fibers of each of the washable, waterproof mascara compositions being the same or different and the synthetic fibers comprising elastomeric fibers. It would have been obvious to one having an ordinary skill in the art at the time the invention was made to construct the fibers of each of the washable, waterproof mascara compositions being the same or different, since such modification would involved an obvious matter of design choice in the shape or size of the known component needed to obtain the desired results. And it would have been obvious to one having an ordinary skill in the art at the time the invention was made to construct the fibers comprising elastomeric fibers, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

This is a provisional obviousness-type double patenting rejection.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Clements is cited to show the state of the art with respect to a

mascara system having two reservoirs and two applicator members. Konik et al is cited to show the state of the art with respect to a mascara waterproof composition. Brieve et al is cited to show the state of the art with respect to a mascara composition.

The drawings filed 01/16/2004 have been approved by the Examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robyn Doan whose telephone number is (571) 272-4711. The examiner can normally be reached on Mon-Fri 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Shaver can be reached on (571) 272-4720. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Robyn Doan
Examiner
Art Unit 3732